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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,573	07/11/2003	Ellen Filvaroff	P1381R1C1P4C1	8245
9157	7590	10/10/2007		
GENENTECH, INC. 1 DNA WAY SOUTH SAN FRANCISCO, CA 94080			EXAMINER JIANG, DONG	
			ART UNIT 1646	PAPER NUMBER
			MAIL DATE 10/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/617,573	Applicant(s) FILVAROFF ET AL.	
	Examiner Dong Jiang	Art Unit 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 September 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection; but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 76-83 and 86.
Claim(s) objected to: 61, 63-66, 68, 69 and 84.
Claim(s) rejected: 70-75 and 85.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Claims 72, 75 and 85 remain rejected under 35 U.S.C. 102(e) as being anticipated by Gorman et al., US6,562,578, for the reasons of record set forth in the previous Office Actions. Applicants argument filed on 6/29/07 has been fully considered, but is not persuasive. Applicants presents similar argument as that the Gorman reference does not support, under 35 U.S.C. 112, first paragraph, the present subject matter and therefore is not a proper 102(e) reference as Gorman does not teach a specific, substantial, and credible utility for the pharmaceutical composition or kit containing the antagonist antibody to the polypeptide of SEQ ID NO:6; Gorman does not teach how to make same; and Gorman does not show its inventors were in possession of the composition and kit; and therefore, cannot be applied under § 102(e). This is not persuasive because, as addressed in the previous Office Actions, MPEP indicates, regarding what constitutes enabling prior art for compounds and compositions, that one of ordinary skill in the art must be able to make or synthesize (MPEP §2121.02), and that in order to constitute anticipatory prior art, a reference must identically disclose the claimed compound, but no utility need be disclosed by the reference. In re Schoenwald, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992) (MPEP §2122). In the instant case, the invention is directed to a product, a pharmaceutical composition of an antibody to the polypeptide of SEQ ID NO:6, which sequence and the antibody to the polypeptide have been disclosed/described in the prior art reference. As such, one of ordinary skill in the art would be able to make (or synthesize) the polypeptide and the antibody thereto according to the teachings of the prior art reference. Thus, the prior art reference meets the anticipating requirement of 102(e).